REMARKS/ARGUMENTS

Claims 1, 4-12, and 27-28 remain in this application. Claims 1 and 28 have been amended as indicated. Support for the amendments are contained in the application as filed. Claim 1 and claim 28 were amended to recite amplifying genomic DNA sequences "within the 3'UTR region" and "within the exon," respectively. Support can be found at, for example, paras. [0005], [0009], [0031], and Figs. 1 and 2.

Applicant acknowledges the withdrawal of the finality of the previous office action.

1. § 112 REJECTION

Claims 1, 4-12, and 27 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is respectfully traversed.

Claim 1 (last line) was amended to clarify "free of polyadenosine sequences" by replacement with "free of a polyA tail." Support for the replacement can be found at, for example, para. [0040] and Fig. 1. Accordingly, amended claim 1, reciting "free of a polyA tail," is now clear on its face, and the rejection should be withdrawn.

2. § 103 REJECTIONS

Claims 1, 4-10, 12, and 27-28 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,274,332 (*Keating*) in view of U.S. Publication No. 2001-0024808 (*White*). The rejection is respectfully traversed.

Applicant respectfully notes that *Keating* mentions in Example 8 using, for example, exon amplification of clones (col. 46, lines 39-45), cDNA libraries and clones (col. 46, lines 60-67), and the complete cDNA was not obtained at this stage (col. 47, lines 3-4) for identifying and characterizing a target gene. In contrast, the present invention avoids many of the problems associated with known library screening

methods such as encountered with generating cDNA fragments from DNA clones or long oligonucleotides. The recited methods can perform large scale amplification of expressed sequences directly from gDNA and use PCR amplifications without cloning to produce amplified sequences having greater relative specificity and size consistency than can be obtained with cDNA fragment approaches, see e.g., page 6, para. [0026].

Similarly, *White* mentions PCR amplification and products of cDNA obtained from clones using plasmid vectors. Contrary to the Examiner's conclusion regarding *White* and the instant claims, the instant claims do not recite microarrays on nylon filters or fibers. Thus, *White's* paras. [0223], [0136], [0248], and elsewhere do not cure the deficiencies of the primary *Keating* reference. It would not have been obvious to combine *Keating* and *White* to arrive at the methods as recited in the instant claims.

Applicant respectfully submits that the combination of *Keating* and *White* fails to teach or suggest, explicitly or inherently, all aspects as recited in amended independent claims 1 and 28. The Examiner has not established a proper *prima facie* case. Accordingly, the rejection is believed to be overcome and should be withdrawn.

Claim 11 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Keating* in view of *White* as applied to claims 1, 4-10, 12, and 27-28 above, and further in view of U.S. Publication No. US-2003-0093227 (*Stoughton*). The rejection is respectfully traversed.

The remarks regarding *Keating* and *White* above are incorporated here by reference. It is respectfully noted that while *Stoughton* may mention [0194] a 94% first-pass amplification success rate it also mentions exclusion of unexpected amplification sizes from further analysis. These and other aspects are avoided by the methods recited in the claims by, for example, printing the product of the second amplification on an array. Applicant's representative respectfully submits that the combination of *Keating* and *White* and further in view of *Stoughton* fails to teach or suggest, explicitly or inherently, all aspects as recited in claim 11.

The Examiner has not established a proper *prima facie* case. Accordingly, the above rejections under 35 U.S.C. 103(a) are believed to be overcome and should be withdrawn.

3. CONCLUSION

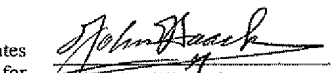
Based upon the above amendments, remarks, and papers of records, applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Applicant believes that a one month extension of time is necessary to make this Reply timely. Should applicant be in error, applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to John L. Haack at (607) 974-3673.

DATE: February 19, 2008

Respectfully submitted,



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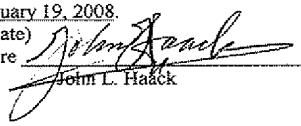
Signature 
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